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v 10-95) Tl	RANSMITTAL LETTER	THE UNITED STATES	9847-00 X PCT PCT						
		ED OFFICE (DO/EO/US)	U.S. APPLICATION NO. (IF KNOWN, SEE 37 CFR						
		09/554912 //							
		NG UNDER 35 U.S.C. 371 INTERNATIONAL FILING DATE	PRIORITY DATE CLAIMED						
	TIONAL APPLICATION NO. PCT/EP98/07740	NOVEMBER 30, 1998	NOVEMBER 28, 1997						
AGNE	INVENTION ETIC ENERGY STORAGE NT(S) FOR DO/FO/US LMBERG- et al.								
pplicant	herewith submits to the United St	ates Designated/Elected Office (DO/EO/US)	the following items and other information:						
ı. 🛛	This is a FIRST submission of	items concerning a filing under 35 U.S.C. 3	71.						
2.	This is a SECOND or SUBSE	QUENT submission of items concerning a fi	ling under 35 U.S.C. 371.						
3. ☒	mi : :	ain notional examination procedures (35 H S	S.C. 371(f)) at any time rather than delay						
_	examination until the expiration	n of the applicable time limit set in 35 U.S.C	the 19th month from the earliest claimed priority date.						
. 🛛			and 17th month from the earnest elained priority date.						
5. 🗵	A copy of the International Ap	plication as filed (35 U.S.C. 371 (c) (2)) h (required only if not transmitted by the Interpretation	ternational Bureau).						
		by the International Bureau.	Cinational 24.335).						
	b.	application was filed in the United States Ro	eceiving Office (RO/US).						
i. 🗆		al Application into English (35 U.S.C. 371(c							
,. □ 7. ⊠									
. <u> </u>	Amendments to the claims of t	he International Application under PCT Arti	cle 19 (35 U.S.C. 371 (c)(3))						
	a. are transmitted herew	rith (required only if not transmitted by the In	nternational Bureau).						
" F	b. have been transmitted	d by the International Bureau.							
}		however, the time limit for making such ame	endments has NOT expired.						
	d. 🛭 have not been made a		2 2 2 4 4 4 4 4 4 4 4 4 4 4 4 4 4 4 4 4						
9. 🗆		A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).							
0.		An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).							
4 . \Box	A copy of the International Pro	A copy of the International Preliminary Examination Report (PCT/IPEA/409).							
2. □	A translation of the annexes to (35 U.S.C. 371 (c)(5)).	A translation of the annexes to the International Preliminary Examination Report under PCT Article 36							
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_	s 13 to 18 below concern docume	eatement under 37 CFR 1.97 and 1.98.	`						
3. 区 4. □	An assignment document for i	recording. A separate cover sheet in complia	ance with 37 CFR 3.28 and 3.31 is included.						
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J. <u>C</u>	A SECOND or SUBSEQUE								
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17. E		A change of power of attorney and/or address letter.							
8. E		Certificate of Mailing by Express Mail							
9.	Other items or information:	Other items or information:							
	Request for Consideration of Notice of Priority Form PTO 1449 List of Related Cases Marked-up Specification Response to Petition Under	of Documents Cited in International Searc	h Report						

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U.S. APPLICATION I	554912	INTERNATIONAL APPLICATION NO. PCT/EP98/07740		ATTORNEY'S DOCKET NUMBER 9847-0058-6X PCT		
20. The foll	owing fees are submitted:.			Ľ	CALCULATIONS	PTO USE ONLY
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	rt has been prepared by the EPO preliminary examination fee paid		\$840.0 82) \$670.00	۱ ۱		
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	ENTER APPROPRI	ATE BASIC FEE	AMOUNT =	• •	\$840.00	
Surcharge of \$130.0	00 for furnishing the oath or decliest claimed priority date (37 C	aration later than FR 1.492 (e)).	□ 20 🖾 3	0	\$130.00	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RAT	Ε		
Total claims	43 - 20 =	23	x \$18.	00	\$414.00	
Independent claims	3 - 3=	0	x \$78.	00	\$0.00	
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months from the earliest claimed priority date (37 CFR 1.492 (f)). TOTAL NATIONAL FEE =					\$1,384.00	
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ec'd PCT/PTO 22 MAY 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Par HOLMBERG, et al.

SERIAL NUMBER:

NEW U.S. PCT APPLICATION (based on PCT/EP98/07740)

FILED:

HEREWITH

FOR:

MAGNETIC ENERGY STORAGE

REQUEST FOR CONSIDERATION OF DOCUMENTS CITED IN INTERNATIONAL SEARCH REPORT

Assistant Commissioner for Patents Washington, D.C. 20231

Sir:

In the matter of the above-identified application for patent, notice is hereby given that applicant(s) request that the Examiner consider the documents cited in the International Search Report according to MPEP §609 and so indicate by a statement in the first Office Action that the information has been considered. When the Form PCT/DO/EO/903 indicates both the search report and copies of the documents are present in the national stage file, there is no requirement for the applicant(s) to submit them (1156 O.G. 91 November 23, 1993).

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

WILLIAM E. BEAUMONT REGISTRATION NUMBER 30,996 Registration No. 25,599

Gregory J. Maier Attorney of Record

Bradley D. Lytle

Registration No. 40,073

Fourth Floor 1755 Jefferson Davis Highway Arlington, Virginia 22202 (703) 413-3000 Fax No. (703) 413-2220 (OSMMN 1/97)



UNITED STATES DEPARTMENT OF COMMERCE Patent and Trader Office ASSISTANT SECRE RY AND COMMISSIONER Washington, D.C. O.S. TO THE PORT OF PATENTS AND THE PROPERTY OF THE PROPERTY **22** MAY 2000

Paper No. 11

Oblon Spivak McClelland Maier & Neustadt 1755 Jefferson Davis Highway Fourth Floor Arlington VA 22202

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SPECIAL PROGRAMS OFFICE DAC FOR PATENTS

In re Application of Mats Leijon, et al Application No. 09/147,325 Filed: February 17, 1999 Attorney Docket No. 9847-0001-

: RESPONSE TO PETITION UNDER : 37 CFR 1.182 SEEKING SPECIAL : TREATMENT RELATING TO AN : ELECTRONIC SEARCH TOOL, AND : DECISION ON PETITION UNDER : 37 CFR 1.183 SEEKING WAIVER : OF REQUIREMENTS UNDER 37 CFR : 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

Part I. Background

Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool

Part III. Petition Under 37 CFR 1.183 - Paper Copies



OBLON, SPIVAK, McCLELLAND. MAIER & NEUSTADT, P.C.

Part IV. Summary

Part V. Further Correspondence

Part 1. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim..." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule¹. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.² In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

- (1)(a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;
- (b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition permitting such procedure and a copy of the Form 1449 (or equivalent); and
- (2) an "electronic search tool" containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

¹Reference to MPEP 2001.05, Petition, page 3.

²Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

 $^{^{3}\}mbox{The original of which would be in the instant holding application.}$

⁴See, Petition under 37 CFR 1.182, infra.

See, Petition under 37 CFR 1.183, infra.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.6

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under the instant decision on the \$ 1.183 petition although it will continue to be considered, with a decision rendered in due

It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty of disclosure issues under 37 CFR 1.56, Petition, fn. 5.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the \$ 1.183

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding the technology; and one set to be used to establish new subclasses for either or both of the other two sets become corrupted (Petition, pages 6 and 7).

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

⁷It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications. In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

<u>Termination</u>: Petitioner seeks a right of termination, which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

⁸The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

⁹Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, 10 on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below. 11

11The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners are whether they include citations from other sources, such as a

¹⁰Even thought the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following 8 conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

preexamination search or third party citations. See also retition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- The grant of the § 1.183 petition re § 1.98(a)(2) does 7) not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, 12 or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
 - The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case will all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

¹²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

By mail: Commissioner of Patents and Trademarks

Box DAC

Washington, D.C. 20231

By FAX: (703) 308-6916

Attn: Special Program Law Office

By hand: Special Program Law Office

Crystal Plaza Four, Suite 3C23

2201 South Clark Place Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the \$ 1.182 petition re the electronic search tool.

Robert 7. Spar

Director

Special Program Law Office

Office of the Deputy Assistant Commissioner

for Patent Policy and Projects

Attachment: List of Digests 13-33

Digest 13 HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.) Digest 14 . Having a particular cable application (e.g., winding, etc.) .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.) Digest 15 Digest 16 .. In a motive power system (e.g., electric motor control system, etc.) Digest 17 .. In an electric power conversion, regulation, or protection system Digest 18 .. In a power distribution network Digest 19 .. In a dynamo-electric machine Digest 20 ... Stator Digest 21 ... Rotor Digest 22 ... Winding, per se Digest 23 .. In a circuit breaker, relay, or switch Digest 24 .. In an inductive device (e.g., reactor, electromagnet, etc.) Digest 25 ... Transformer Digest 26 . Having a plural-layer insulation system Digest 27 ... Including a semiconductive layer Digest 28 ... Plural semiconductive layers Digest 29 . Having a semiconductive layer Digest 30 . Having insulation with a particular dimension or geometry Digest 31 . Having a shield or metallic layer Digest 32 . Having means for cooling Digest 33 . Method of cable manufacture, assembly, repair, or splicing